

REMARKS

The examiner finally rejected claims 1-3 under 35 USC 102(e) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over US Patent No. 6,365,700 to Graham ("Graham"). The examiner rejected claim 4 under 35 USC 103(a) as being unpatentable over Graham as applied above, and further in view of US Patent No. 5,939,499 to Anderson, et al. ("Anderson").

Claims 1-2 are directed to a method for forming a moisture reactive hot melt adhesive including: forming a hydroxyl-functional prepolymer by reacting first components comprising a polyol selected from the group consisting of polyether polyols, polyester polyols, and mixtures thereof, the polyol having a weight average molecular weight of from 250 to 5,000; and a polyisocyanate, the ratio of OH/NCO groups of the first components on an equivalents basis being from 1.05 to 3.0; admixing second components including the hydroxyl-functional prepolymer, a crystalline polyester polyol, and a polyisocyanate, the weight ratio of the hydroxyl-functional prepolymer to the polyol being from 9/1 to 1/9, and the ratio of NCO/OH groups of the second components on an equivalents basis being from 1.5 to 2.2; and reacting, or allowing to react, the admixture. Claim 3 is directed to a moisture reactive hot melt adhesive formed by the method of claim 1 or claim 2. Claim 4 is directed to a method for bonding substrates including the step of: forming a moisture reactive hot melt adhesive by the method of claim 1 or claim 2.

35 USC 102(e) REJECTION OF CLAIMS 1-3

The examiner rejected claims 1-3 under 35 USC 102(e) as being anticipated by Graham. The examiner points to certain elements in Graham but Graham does not disclose admixing second components specifically including the combination of a hydroxyl-functional prepolymer, a crystalline

polyester polyol, and a polyisocyanate in the weight ratio of the hydroxyl-functional prepolymer to the polyol of from 9/1 to 1/9. Further, claim 1 (and claims 2-3 which depend therefrom) recites the polyol of the first components as having a weight average molecular weight of from 250 to 5,000. Graham's disclosures do not provide appellant's invention of claims 1-3 with a sufficient degree of specificity to represent anticipation under 35 USC 102(e).

Appellant submits and the examiner agrees that Graham's Example 2, pointed out earlier in the prosecution, is not an anticipating disclosure.

Appellant respectfully submits that each and every limitation of his invention of claims 1-3 is not disclosed by Graham. Appellant urges that his claims 1-3 are not anticipated by Graham under 35 USC 102(e).

35 USC 103(a) REJECTION OF CLAIMS 1-3

The examiner rejected claims 1-3 under 35 USC 103(a) as being obvious over Graham. Appellant traverses because the examiner does not meet his burden of providing a prima facie case of obviousness by pointing out any teaching or suggestion within Graham to modify Graham's method or composition. The examiner points to certain related elements in Graham but Graham does not disclose admixing second components including the selected combination of a hydroxyl-functional prepolymer, a crystalline polyester polyol, and a polyisocyanate, the weight ratio of the hydroxyl-functional prepolymer to the polyol being from 9/1 to 1/9.

Further, claims 1-3 recite the polyol of the first components as having a weight average molecular weight of from 250 to 5,000. Graham discloses molecular weights in the range of 2000 to 15,000 with the best commercially available polyester having a molecular weight of 7,200, but states that "if a lower molecular weight hydroxyl terminated polyester is used, i.e., one with a molecular weight of 3600 ... the viscosity of the resulting prepolymer is too high for efficient mixing..." (Graham, page 4, lines 19-22), thus points out that a first component polyol molecular weight of 3600 is inappropriate in

Graham's own method, thereby teaching away from the lower molecular weights claimed by appellant. Surely, this disclosure does not motivate one skilled in the art to use the lower molecular weight polyols of the first components as claimed by appellant.

Appellant respectfully submits that Graham provides no teaching, suggestion, or motivation to appellant's method or composition as claimed. Appellant respectfully concludes that his claims 1-3 are not obvious over Graham under 35 USC 103(a).

35 USC 103(a) REJECTION OF CLAIM 4

The examiner rejected claim 4 under 35 USC 103(a) as being unpatentable over Graham as applied above, and further in view of Anderson. The examiner argues that Graham teaches all of the limitations of claim 4 except for a teaching of a method for applying a moisture reactive hot melt adhesive. Appellant traverses, *inter alia*, because Graham does not disclose each and every limitation of claim 1, and claim 2 which is dependent therefrom, which read into claim 4. Further, claims 1-2 and, as argued herein above, are not taught or suggested by Graham. Therefore the teachings of Graham cannot be perfected by Anderson which is directed to a method for applying different hot melt adhesives. Appellant respectfully concludes that his claim 4 is not obvious over Graham in view of Anderson under 35 USC 103(a).

Respectfully Submitted,



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